UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

JAN - 3 2002

#15

DAVID W. CLOUGH
KATTEN MUCHIN ZAVIS
525 W. MONROE STREET, SUITE 1600
CHICAGO, ILLINOIS 60661

In re Application of	:
McCafferty et al	:
Serial No.: 09/417,479	: PETITION DECISION
Filed: October 13, 1999	: under 37 C.F.R. 1.181
Attorney Docket No.: 13839-00011	:

This is in response to applicants' renewed petition filed under 37 C.F.R. 1.181 on 27 September 2001, to request that a sequence listing is not required for the present application under MPEP 2421.01. The delay in acting on this petition is regretted.

BACKGROUND

The petition was filed in response to a Petition Decision mailed 14 June 2001 and re-mailed 23 July 2001, which was denied and required Applicants to comply with the Sequence Requirements of 37 C.F.R. 1.821-1.825.

A review of the '479 file shows that the instant application was filed as a continuing application under 37 C.F.R. 1.53(b) (Paper No. 2 filed 10/13/99). Further, as the petition correctly states, the instant application is a divisional of 08/484,893, which was a continuation of 07/971,857 which was a U.S. national stage filing of PCT/GB91/01134.

The exemption from filing a sequence listing as discussed in MPEP 2421 is limited to the national stage filing under 37 C.F.R. 371. In the instant application's lineage, that exemption is only granted to the 07/971,857 application which was the national stage filing under 37 C.F.R. 371. Continuations and divisionals of national stage filings are filed under 35 USC 111 are treated as new applications and as such, are required to comply with 37 C.F.R. 1.821-1.825.

The Petition asserts that compliance with the requirements of 37 C.F.R. 1.821-1.825 may be waived under exceptional circumstances and cites MPEP 2421.01. Applicants submit that requiring the present application to comply with the Sequence Listing Rules would place undue hardship on Applicants because the sequence data is currently not available

on any computer readable form. Applicants further submit that manually entering the formatting the numerous peptide and nucleotide sequences would require a huge expenditure of time and expense without providing commensurate benefit to either the Office or the public. Finally, the petition asserts that submitting a second substitute specification would be excessively time consuming.

DISCUSSION

These arguments have been considered carefully and found to be not persuasive for the following reasons.

(1) With regard to the burden of filing a substitute specification, it is noted that compliance with the sequence requirements does not necessarily result in need for a substitute specification.

A review of the 299-page specification shows that sequences are found on pages 158, for example. Applicants may insert the SEQ ID Nos for these sequences by replacing the text of the paragraph within which the sequence is found. Additionally, a sequence listing can be added, by amendment to the specification.

A review of the 53 drawings shows that sequences are present in Figure 16, for example. In order to comply with the sequence requirements, SEQ ID Nos need to be added to the specification to describe those sequences recited in the Figures. This may be accomplished by filing new drawings that recite the SEQ ID Nos. Alternatively, the SEQ ID Nos may be added as amendments to the Brief Description of the Drawings to describe the sequences in the Figures. As claim 49 recites DNA sequences having SEQ ID Nos 7-17, compliance to the sequence requirement is required, not only by 37 CFR 1.1.821-1.825 but also by35 USC 112, first and second paragraphs.

While it is acknowledged that compliance with the sequence requirements will require a lengthy amendment, the benefit obtained by Applicants, the Office and the public out-weigh and justify the requirement.

(2) With regard to the difficulty of manually entering and formatting the disclosed peptide and nucleotide sequences in a computer readable form, applicants should note that the conversion of written material to an electronic format is becoming more and more standard. Electronic scanning devices may aid applicants in their effort to convert the written sequences to a computer readable format. Further, assistance in downloading the PatentIn 3.1 software can be obtained from General Information Service at (800) 786-9199 or (703) 308-4357. Additional help related to using the PatentIn 3.1 software can be obtained by calling the PatentIn Help Line at (703) 306-4199 or by e-mail at patin3help@uspto.gov.

(3) With regard to the commensurate benefit, applicants' compliance with the sequence requirements will enable examiners to easily identify this pending application as prior art when searching other applications claiming the disclosed sequences. This benefit will be extended to the public should the application be issued and should the sequences be contained in the sequence database. A U.S. Patent is a right conveyed to applicants in

exchange for disclosure of the invention. Part of applicants' disclosure is the sequences recited in the Figures and in the specification. Once the application is issued, the content of the disclosure needs to be made available to the public in a format amenable to searching. It has been and remains standard practice that peptide and nucleotide sequences are searched using computer readable format.

For all of these reasons the examiners requirement that the applications comply with the sequence requirements is proper and is not withdrawn.

Related application 08/273,146, filed 14 July 1994, and issued as U.S. Patent 5,855,885 on 5 January 1999, also claims priority to PCT/GB91/01134 and has complied with the sequence requirements. If sequences are identical between these applications, the computer readable form may be easily transferred from '146 to the '479 application using the procedures set forth in MPEP 2422.05.

Finally, in an effort to reduce the applicants burden, it is noted that applicants may chose to delete from the specification and drawings any sequences that are not (1) recited in the claims, and (2) required for enablement, written description, new matter or priority considerations.

DECISION

Applicants' petition is **DENIED** for the reasons set forth above.

Applicants are required to comply with the requirements of 37 C.F.R. 1.1821-1.825, as set forth on the letter sent 12 December 2000, Paper No. 20.

Should applicants persist in their desire to have the rules waived (37 CFR 1.821-1.825), a separate petition under 37 CFR 1.183 mist be filed and be directed to the Office of Petitions within **TWO MONTHS** of the mailing date of this decision.

Should there be any questions with regard to this letter please contact Julie E. Burke, Ph.D. by letter addressed to the Group Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-7553 or by facsimile transmission at (703) 305-7939.

Bruce Kisliuk
Group Director
Technology Center 1600